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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,729	03/28/2001	Eriko Goto	81754.0056	5473

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EXAMINER

DAVIS, ZACHARY A

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/821,729

Applicant(s)

GOTO ET AL.

Examiner

Zachary A. Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-9 and 11-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-9 and 11-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. An amendment was received on 09 February 2005. Claims 1, 3, 4, 9, 11, 15-17, and 19 have been amended. Claims 2 and 10 have been canceled. No new claims have been added. Claims 1, 3-9, and 11-19 are currently pending in the present application.

Priority

2. The Examiner thanks Applicant for submission of their receipt acknowledgement. The certified copy is in the present application file. The attached form PTOL-326 has been marked "All certified copies of the priority documents have been received" in order to reflect this.

Response to Arguments

3. Applicant's arguments filed 09 February 2005 have been fully considered but they are not persuasive.

Claims 1-16 were rejected under 35 U.S.C. 103(a) as unpatentable over Nishiyama et al, US Patent 5844691, in view of Barlow, US Patent 5204961. Claims 17-19 were rejected under 35 U.S.C. 102(b) as anticipated by Nishiyama.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In reference to independent Claims 1, 9, 15, 17, and 19, Applicant argues that Nishiyama does not disclose a "one-way communication barrier" (see page 15 of Applicant's arguments). Applicant further argues that Nishiyama instead discloses an electronic mail transmitting *and* receiving portion, and Applicant alleges that therefore, it is clear that data can be both read to and written from that portion. The Examiner respectfully disagrees. It is first noted that Applicant discloses "a mail transfer section 40" having "a mail receiving section 41 and a mail sending section 42" (see page 20 of Applicant's substitute specification, and Figure 5 of the present application); this appears to correspond strongly to the mail transmitting and receiving portion described by Nishiyama. Further, it is noted that different protocols are used for sending and receiving electronic mail, and that a receiving portion, receiving mail sent by the SMTP (simple mail transfer protocol), does not use the same data format as a sending portion, sending mail that is to be received by the POP3 (post office protocol version 3). See the definitions of SMTP and POP3 (retrieved from the Free On-Line Dictionary of Computing), noting that POP3 does not provide for sending mail (POP3 definition, end of the first paragraph) and that SMTP does not provide for access of the messages (SMTP definition, first paragraph). Therefore, the Examiner believes that the

transmitting and receiving portion of Nishiyama must provide separately for the sending and receiving functions, and further that it would be impossible to write other data in the internal format to the receiving section and read other data in the external format from the sending section.

Therefore, for the reasons detailed above, the Examiner maintains the rejections as set forth below.

Specification

4. Although Applicant has corrected the specific errors that were referred to in the prior Office action, it is noted that those errors were cited as examples, and the specification still appears to contain other typographical and grammatical errors. These errors will not be enumerated here. Applicant's cooperation is therefore requested in carefully correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Nishiyama et al, US Patent 5844691.

In reference to Claim 17, Nishiyama discloses a network security system including a server including a mail client and a mail server (column 17, lines 54-63, and column 18, lines 31-40), a mail transfer section including a mail receiving section and mail sending section (Figure 16, Email Transmission and Receiving Portion 2208, and Figure 17, Email Transmission and Receiving Portion 2308), and that a host computer receives data transfer from the server through the mail receiving section (column 17, line 64-column 18, line 3) and transfers data to the server through the mail sending section (column 18, lines 41-47). It is noted that a mail receiving section and a mail sending section must necessarily function independently, specifically in that a mail sending section cannot receive mails and a mail receiving section cannot send mails, due to the differing protocols used.

In reference to Claim 18, Nishiyama discloses that the communication line is dedicated to mail (see Figure 16, elements 2208 and 2014, and Figure 17, elements 2308 and 2024).

In reference to Claim 19, Nishiyama discloses a network security system including a mail server (column 17, lines 54-63, and column 18, lines 31-40), a mail transfer section including a mail receiving section and a mail sending section (Figure 16, Email Transmission and Receiving Portion 2208, and Figure 17, Email Transmission and Receiving Portion 2308), and that a host computer receives data transfer from the

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mail server through the mail receiving section (column 17, line 64-column 18, line 3) and transfers data to the server through the mail sending section (column 18, lines 41-47).

It is noted that a mail receiving section and a mail sending section must necessarily function independently, specifically in that a mail sending section cannot receive mails and a mail receiving section cannot send mails, due to the differing protocols used.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishiyama in view of Barlow, US Patent 5204961.

In reference to Claim 1, Nishiyama discloses a server (column 17, lines 54-60), a received data storage means (column 17, lines 64-67), and a received data format conversion means (column 18, lines 3-7). Nishiyama also discloses a database for storing received, format-converted data (Figure 16, Data Base Portion 2203). Further, it is noted that, as the received data storage means receives mail data, due to the independent nature of mail receiving and sending protocols, that mail data received by the received data storage means cannot be sent as mail data. However, Nishiyama

does not explicitly disclose a host computer executing a process using the data with the internal format.

Barlow discloses a network security system including a received data storage means (Figure 3, Transport and Network Services 172), a received data format conversion means (Figure 3, Trust Realm Service Program 174; column 8, lines 44-49), and a host computer executing a predetermined process using the received, format-converted data (Figure 3, Receiving Application 186). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Nishiyama by including the host computer as taught by Barlow, in order to strengthen the trust between computers communicating over an insecure network by enforcing common security protocols for the protection of confidential data (see Barlow, column 2, lines 8-17).

In reference to Claim 3, Barlow further discloses that the communications are unidirectional between the server, received data storage means, received data format conversion means, received process data storage means, and host computer (see Figure 3, where the message 153 travels in one direction from the network 110 to the receiving application 186). Further, as Nishiyama discloses that the received data storage means receives mail data, due to the independent nature of mail receiving and sending protocols, that mail data received by the received data storage means cannot be sent as mail data.

In reference to Claim 4, Nishiyama further discloses storing and sending data with a predetermined time period (column 18, lines 41-43 and 65-67).

In reference to Claim 5, Nishiyama further discloses executing processes in a lump sum manner (column 18, lines 18-23) and with independent timing (column 18, lines 41-43, and column 18, line 67-column 19, line 9).

In reference to Claim 6, Nishiyama further discloses that the data is converted to a database format (column 18, lines 3-7).

In reference to Claim 7, Nishiyama further discloses that the server sends data with a mail format (column 17, line 64-column 18, line 3).

In reference to Claim 8, Nishiyama further discloses sending data over the Internet (column 17, lines 64-67).

In reference to Claim 9, Nishiyama discloses a transmit process data storage means, a transmit data format conversion means (column 18, lines 41-47), and a server (column 18, lines 31-37). Nishiyama also discloses a database from which data, originally in an internal format, is sent (Figure 17, Data Base Portion 2303). Further, it is noted that, as a transmit data storage means sends mail data, due to the independent nature of mail receiving and sending protocols, that mail data sent by the transmit data storage means cannot be read as mail data from the transmit data storage means. However, Nishiyama does not explicitly disclose a host computer executing a process using data with an internal format.

Barlow discloses a network security system including a transmit data format conversion means (Figure 3, Trust Realm Service Program 156; column 7, lines 28-33), a transmit data storage means (Figure 3, Transport and Network Services 155), and a

host computer executing a predetermined process using data with an internal format that is to be sent (Figure 3, Initiating Application 152). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Nishiyama by including the host computer as taught by Barlow, in order to strengthen the trust between computers communicating over an insecure network by enforcing common security protocols for the protection of confidential data (see Barlow, column 2, lines 8-17).

In reference to Claim 11, Barlow further discloses that the communications are unidirectional between the host computer, transmit process data storage means, transmit data format conversion means, transmit data storage means, and server (see Figure 3, where the message 153 travels in one direction from the initiating application 152 to the network 110). Further, as Nishiyama discloses that the transmit data storage means sends mail data, due to the independent nature of mail receiving and sending protocols, that mail data sent by the transmit data storage means cannot be read as mail data from the transmit data storage means.

In reference to Claim 12, Nishiyama further discloses executing processes with independent timing (column 18, lines 41-43, and column 18, line 67-column 19, line 9).

In reference to Claim 13, Nishiyama further discloses that the server receives data with a mail format (column 18, lines 41-47).

In reference to Claim 14, Nishiyama further discloses sending data over the Internet (column 17, lines 64-67).

In reference to Claim 15, Nishiyama discloses a received data storage means (column 17, lines 64-67), a received data format conversion means (column 18, lines 3-7), a transmit process data storage means, a transmit data format conversion means (column 18, lines 41-47), and a server (column 17, lines 54-60; column 18, lines 31-37). Nishiyama also discloses a database for storing received, format-converted data (Figure 16, Data Base Portion 2203). Further, it is noted that, as the received data storage means receives mail data, due to the independent nature of mail receiving and sending protocols, that mail data received by the received data storage means cannot be sent as mail data. It is additionally noted that, as a transmit data storage means sends mail data, due to the independent nature of mail receiving and sending protocols, that mail data sent by the transmit data storage means cannot be read as mail data from the transmit data storage means. However, Nishiyama does not explicitly disclose a host computer executing a process using the data with the internal format.

Barlow discloses a network security system including a received data storage means (Figure 3, Transport and Network Services 172), a received data format conversion means (Figure 3, Trust Realm Service Program 174; column 8, lines 44-49), and a host computer executing a predetermined process using the received, format-converted data (Figure 3, Receiving Application 186). Barlow further discloses a transmit data format conversion means (Figure 3, Trust Realm Service Program 156; column 7, lines 28-33) and a transmit data storage means (Figure 3, Transport and Network Services 155). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Nishiyama by

including the host computer as taught by Barlow, in order to strengthen the trust between computers communicating over an insecure network by enforcing common security protocols for the protection of confidential data (see Barlow, column 2, lines 8-17).

In reference to Claim 16, Nishiyama further discloses executing processes with independent timing (column 18, lines 41-43, and column 18, line 67-column 19, line 9).

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachary A. Davis whose telephone number is (571) 272-

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3870. The examiner can normally be reached on weekdays 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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